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In re Application of: Shah, et al.

Serial No.: 09/324,182

Group Art Unit: 1615

Filed: June 2, 1999

Examiner: Pulliam, Amy

For: Non-Tacky Mascara Composition

9/Req for
Recons w/att
9/11
5-23-01

RESPONSE PURSUANT TO 37 CFR 1.113

The Assistant Commissioner of Patents and Trademarks

Washington, D.C. 20231

Dear Sir:

Beet
5-30-01

In the Examiner's Final Action dated February 23, 2001, Claims 1, 2, 7-19, 21, 22, 24 and 25 are rejected under 35 U.S.C. §102(b) as being anticipated by Pastour et al. (U.S. Pat. No. 5,523,091, hereinafter referred to as "the Pastour reference") and Claims 1-30 are rejected under 35 U.S.C. §103 as being unobvious in light of the Pastour reference. The Examiner argues that the Pastour compositions contain plant extracts that are active principles. Applicants previously argued that the plant extracts of the Pastour reference are not the plant extracts of the present invention. In the present response, Applicants further elaborate on the differences between the two "plant extracts" and demonstrate why the Pastour reference fails to disclose the present invention, and fails to render the present invention obvious.

a. Present Invention Uses Substantially Unfiltered Plant

The present invention is a mascara composition that contains a plant extract prepared using the whole unfiltered fruit or vegetable. The components of the plant, in the form of a fruit or vegetable, is not separated or purified to make the extract of the present invention. Specifically at page 3, lines 24 to 32, the term "plant extract" is defined to have this special meaning such that the plant extract includes, except for the seeds, all of the constituents of the fruit of vegetable because they are not filtered. As recently supported by the decision in *Hockerson-Halberstadt Inc. v. Avia Group International Inc.*, 55 USPQ2d 1487, 1490 (CAFC 2000), although an ordinary meaning of a claim term is initially used as a default, the term may have a special meaning applied if the term is clearly defined in the specification because the patentee may act as a lexicographer and

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provide a different, or modified, meaning to the term. *Hockerson*, 55 USPQ2d at 1490 (citing *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998) (observing that an applicant, acting as a lexicographer, may bestow "a special meaning to a term in order to convey a character or property or nuance relevant to the particular invention"); *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1671, 1674 (Fed. Cir. 1994)). The nuance of the present invention is the substantially unfiltered plant extract whereby the whole pulp and skin of the plant are used in the compositions of the present invention. The Pastour reference does not disclose a composition containing a seedless but substantially unfiltered plant extract as such is defined in the present specification, and therefore, the Pastour reference fails to disclose the present invention.

b. Pastour Patent uses a Constituent Separated from Plant

In contrast to the present invention, the Pastour compositions can contain active ingredients such as plant extracts. The present issue is: what is a "plant extract" as the term is used in the Pastour reference. Unlike the present specification, the Pastour references is devoid of a special definition of a plant extract, and thus, the ordinary and accustomed meaning of the term applies to the use of the term "plant extract" in the Pastour reference. *Hockerson*, 55 USPQ2d at 1490.

Evidence in the Pastour reference, and reference material indicates that the ordinary use of the term "plant extract" by one skilled in the art means a constituent separated from a whole plant containing a mixture of components. As mentioned in the present specification, at page 3, lines 28 to 30, contrary to the present invention, a plant extract is typically made by a separation procedure which removes the desired constituent from the whole plant. Consistent with this customary definition, an Analytical Chemistry Handbook, defines an "extraction" to be the process of selectively removing a solute, as for example an active principle, from a mixture with solvents, or the like. Dean, J. A., Analytical Chemistry Handbook, Chapter 2.2 Extraction Methods, pp. 2.15 to 2.59, McGraw-Hill (1995)(copy submitted herewith). In addition, the Webster's Encyclopedic Unabridged Dictionary of the English Language defines the noun "extract" to be a solution containing the active principles of a drug, plant juice, or the like, and to be a solid, viscid, a liquid substance extracted from a plant, drug, or the like. The verb "extract" means to separate or obtain (a juice, ingredient, principle, etc.) from a mixture by pressure, distillation, treatment with solvents or the like. Webster's Dictionary, Gramercy Books (1989) p. 505 (copy submitted herewith). As

used at column 6, lines 3 to 7 of the Pastour reference, the “plant extract” is the source of the active principle which is extracted from a whole plant (i.e., the plant extract is separated from the whole plant to provide the active principle, oil, or filler.)

The Pastour reference fails to disclose a substantially unfiltered plant extract in its compositions. A prior art reference fails to anticipate if it does not disclose each and every element of the claimed invention, and if the missing element is not inherent in the prior art reference. *In re Robertson*, 49 USPQ2d 1949, 1951 (CAFC 1999)(citation omitted). To establish inherency, the extrinsic evidence "must make clear that the missing element is necessarily present in the subject matter described in the prior art reference, and that it would be recognized by those of ordinary skill in the art." *Id.* (citing *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991)). Only the active principle is used in the Pastour compositions, and one of ordinary skill in the art would recognize that the presence of the other constituents from the unfiltered plant is likely to interfere with the activity of the desired active principle and that the mixture of additional constituents from the whole plant may cause other qualitative disadvantages to the final composition. Thus, the Pastour reference fails to disclose, expressly or inherently, the substantially unfiltered plant extract of the present invention.

Because the Pastour reference does not disclose an unfiltered plant extract it does not anticipate the present invention. Therefore, Applicants request that the rejection under 35 U.S.C. §102(b) be withdrawn.

c. Present Invention is Unobviousness

The Examiner asserts that the Pastour reference also renders the present invention obvious because the expected result would be a mascara that is soft, uniform, and has good hold and sensory qualities. Using the “plant extract” of the Pastour reference this could be expected by one of ordinary skill in the art because the plant extract in the Pastour reference, as demonstrated above, is a constituent separated from the mixture of constituents in the whole plant. The process of extraction filters the desired constituent from the undesired constituents. In the case of plants, and especially fruits and vegetables, some of the undesired constituents include pulp, sugars, and other sticky and tacky compounds. The Pastour reference fails to teach or suggest the incorporation of all of these various constituents, that exist in the unfiltered plant extract, in its compositions, and therefore, the present invention is unobvious in view of the Pastour reference.

The Examiner points out that the Pastour reference fails to teach the specific percent of plant extract claimed in Claim 3 of the present invention. In addition, the Pastour reference incorporates its plant extract in the aqueous phase of its compositions, unlike the compositions of the present invention. Adding pulp and sugar to water increases the tackiness of the water phase, and therefore, the Pastour reference fails to teach or suggest a non-tacky composition containing an unfiltered plant extract. In contrast to the Pastour reference, the present invention incorporates in its mascara compositions the unfiltered plant extract, and it is surprisingly not tacky.

The achievement of the present invention is surprising as mentioned in Applicants' previous response of January 2, 2001; however, the Examiner interprets the study described in the present specification to mean that 87% or more of the participants rate the mascara of the present invention as performing the same as their currently used mascara, and therefore, the Examiner concludes that the results of the present invention are not surprising. Applicants assert that although the interpretation is correct, the conclusion is not. The Pastour reference is no different than conventional mascaras, and the ability of the mascara of the present invention to perform as well as traditional mascara is indeed unexpected because it contains nearly all of the components of the fruit or vegetable which would be expected to cause the mascara to perform poorly. As the Examiner has noted the mascara should be easy to apply, soft, uniform, and have good sensory qualities. Formulating a mascara with conventional synthetic ingredients to achieve these qualities is difficult enough. It is not expected that a mascara formula containing raw, substantially unfiltered fruits and vegetables would be able to achieve these qualities at all, nonetheless to perform comparably to conventional mascaras that are formulated to achieve these qualities with synthetically derived ingredients. Despite conventional wisdom, the mascara of the present invention containing unfiltered fruit extract (i.e., containing sticky sugar, gummy and tacky pulp) is favorably compared with conventional mascaras that do not contain these ingredients and it is hard to reconcile how this could be anything but surprising.


Applicants submit that the claims of the present application satisfy the requirements of 35 U.S.C. §103(a) because the Pastour reference fails to teach or suggest a substantially unfiltered plant extract as described in the present specification. Unlike the present invention, the plant extract in the Pastour reference is separated from the whole plant. Further, the mascara of the present invention containing the unfiltered plant extract is surprisingly and unexpectedly non-tacky. Thus, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

Applicants believe that the present claims are patentable over the cited prior art reference. Accordingly, the claims, as amended, are believed to be in condition for allowance, and issuance of a Notice of Allowance is respectfully solicited.

Respectfully submitted,

5/23/01



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